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Commissioner of Patents
U.S. Patent and Trademark Office
Customer Service Window, MS Patent Ext.
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Re: Application for Patent Term Extension
Appl. No.: 09/978,178
Filed: October 17, 2001
Title: **Peptides Derived from the Human
Amyloid Precursor Protein**
Inventor(s): Rogers, Jack
Atty. Dkt.: 7570/73272

Dear Sir:

The following documents are being forwarded herewith for appropriate action by the U.S. Patent and Trademark Office:

1. Application for Patent Term Extension Under 37 C.F.R. § 1.705(b); and
2. Return postcard.

The Director is hereby authorized to charge the following fee to our Deposit Account No. 06-1135 under Order No. 7570/73272:

Application for Patent Term Extension

\$ 200.00

Commissioner for Patents
August 31, 2005
Page 2

The Director is also authorized to charge any fee deficiency with respect to this filing and any other fee required in connection with the present case, or credit any overpayment, to our Deposit Account No. 06-1135 under Order No. 7570/73272.

It is respectfully requested that the enclosed postcard be stamped with the date the enclosed documents are received by the PTO and that it be returned as soon as possible.

Very truly yours,

FITCH, EVEN, TABIN & FLANNERY

A handwritten signature in black ink, appearing to read "Michael A. Sanzo". The signature is written in a cursive, flowing style.

Michael A. Sanzo
Reg. No. 36,912
Attorney for Applicant

MAS:ct
Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Rogers, Jack

Appl. No.: 09/978,178

Filed: October 17, 2001

For: **Peptides Derived from the Human
Amyloid Precursor Protein**

Confirmation No.: 3914

Group Art Unit: 1649

Examiner: Hayes, R.

Atty. Dkt.: 7570/73272

Application for Patent Term Adjustment Under 37 C.F.R. § 1.705(b)

Commissioner of Patents
U.S. Patent and Trademark Office
Customer Service Window, **MS Patent Ext.**
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Sir:

Applicant has received the Notice of Allowance and Fee(s) Due for the above-captioned application that was sent by the U.S. Patent and Trademark Office on August 17, 2005. Accompanying this was a "Determination of Patent Term Adjustment under 35 U.S.C. 154(b)." This indicates that Applicant is entitled to 273 days of extension of patent term. However, Applicant believes that this is incorrect and that there should actually be extension of 376 days. The basis for Applicant's conclusion is set forth below.

I. Chronology of Relevant Prosecution Dates

October 17, 2001	Application filed;
May 17, 2002	Notice to File Missing Parts mailed by the PTO;
August 19, 2002	Response filed;
January 21, 2004	Restriction requirement sent by the PTO;
February 17, 2004	Response filed;
May 6, 2004	First Office Action sent by the PTO;
July 26, 2004	Response to first Office Action filed;
October 18, 2004	Second Office Action sent by the PTO;

December 20, 2004	Response to second Office Action filed;
February 9, 2005	Notice of Appeal filed;
March 7, 2005	Advisory Action sent by the PTO;
May 23, 2005	Request for Continued Examination filed; and
August 17, 2005	Notice of Allowance sent by the PTO.

II. Statement of Relevant Facts

Applicant believes that there are three dates in the above chronology that are important with respect to patent term adjustment. The first is August 19, 2002. On this date, Applicant filed a response to a Notice to File Missing Parts that had been sent on May 17, 2002. Since Applicant's response was more than three months after the Notice was sent, a reduction in term corresponding to the difference between August 17, 2002 (the date three months after the Notice was mailed) and August 19, 2002 (the date on which Applicant filed the response) should occur. Thus, term should be reduced by two days.

A second important event occurred on January 21, 2004. On this date, the Patent Office sent a restriction requirement which was the first substantive Office Action mailed for this application. Under the existing rules, the Patent Office must mail such an Office Action within 14 months of Applicant's filing date. Thus, the PTO was required to mail a first substantive Office Action on or before December 17, 2002. Term should be added for every day after this date until a substantive Office Action is actually mailed. Therefore, Applicant should be entitled to an addition to term equivalent to 400 days, *i.e.*, corresponding to the number of days beginning on December 18, 2002 and ending on January 21, 2004. Both with respect to this calculation and the calculation of a two-day deduction in term described above, Applicant is in agreement with the calculation of the Patent Office that appears on the PAIR page for the application in which patent term calculations are listed.

The third important event is the one in which Applicant is in disagreement with the PTO's calculation appearing on the PAIR page. The important chronology of events in this case is: the PTO mailed an Office Action on October 18, 2004; Applicant responded on December 20, 2004; and Applicant then filed a Notice of Appeal on February 9, 2005.

Applicant recognizes that the filing of the Notice of Appeal should result in a reduction of term extension. Based upon Applicant's reading of the rules and their discussions with the Office of Patent Term Adjustment at the PTO, it is Applicant's understanding that after the mailing of a final rejection, they have three months to respond but that the filing of an Amendment Under §116 only constitutes a response for patent term extension purposes if it puts the application in condition for allowance. The filing of a Notice of Appeal however is sufficient to constitute a response for patent term extension purposes regardless of whether the claims are allowable or not. Since Applicant filed the Notice of Appeal more than three months after the receipt of the "final" Office Action, term should be deducted for each day beyond the three month limit. Thus, term should be deducted for the period from January 18, 2005 to February 9, 2005, a total of 22 days. Applicant does not believe that the subsequent filing of a Request for Continued Examination (RCE) should have any effect on term at all. Accompanying the RCE, Applicant resubmitted the same response that was filed on December 20, 2004 but this was done because the Examiner expressly stated in the Advisory Action that the amendments filed on December 20 would not be entered. Thus, the submission accompanying the RCE should not be considered as a second filing of the same response to the final Office Action but rather as part of the RCE itself.

According to the PAIR page for the above-captioned application, patent term adjustment was reduced by 125 days. This was time equivalent to the period from October 18, 2004, the date on which the PTO mailed its Office Action, until May 23, 2005, which the PAIR page indicates is the date on which a Notice of Appeal was filed. However, this is incorrect. The Notice of Appeal was filed on February 9 2005 and *not* on May 23, 2005. Applicant therefore respectfully submits that the calculation of the PTO as set forth in the PAIR page is incorrect and that term should actually only be reduced by 24 days, as discussed above (22 days for the late filing of the Notice of Appeal and 2 days for the late filing of the response to the Notice to File Missing Parts).

Using all of the adjustments discussed above, Applicant believes that delays by the PTO resulted in a potential addition to patent term of 400 days and that delays by Applicant

resulted in a reduction of this by 24 days. In other words, Applicant should be entitled to a total term adjustment of 376 days.

The application described above is not subject to a Terminal Disclaimer.

Conclusion

Based upon the above considerations, Applicant respectfully requests reconsideration of the patent term adjustment that should be available for the present claims. As discussed above, Applicant believes that this should be for a total of 376 days.

The Director is hereby authorized to charge our Deposit Account No. 06-1135 \$200 for the fee set forth in 37 C.F.R. § 1.18(e) under Order No. 7570/73272. The Director is further authorized to charge any fee deficiency with respect to this filing and any other fee required in connection with the present case, or credit any overpayment to our Deposit Account No. 06-1135 under Order No. 7570/73272.

If a phone call would help to expedite this matter, the Examiner is invited to call Applicant's undersigned attorney at (202) 419-7013.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: 

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Attorney for Applicant

Date: August 30, 2005
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